

REMARKS

Claim Rejections - 35 U.S.C. §102

Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by Yacoob (U.S. Patent No. 6,557,752 B1).

In column 6, lines 25-28 of Yacoob, it is specifically stated that the “[s]tate-of-the-art in smart card technology allows storing 8 KBytes on a single smart card. This storage capacity is increasing at a fast rate and is expected to reach 32 KBytes in the near future (1-2 years).”

Therefore, the storage capacity of Yacoob is in the range of kilobytes. This is considered to be a very limited amount of storage space. In fact, its storage capacity is thousands of times smaller than a simple 1.44Mbyte computer diskette. In contradistinction, in the present invention, the portable storage medium 5 is shown to be in a disc-shape in Figure 1. For a compact disc, it is known to have 700Mbyte. For a digital video disc, it is known to have 4.7Gbyte. Therefore, the storage capacity is far greater than the smart card of Yacoob. To reflect these differences in the claim language, independent claim 1 has been amended to recite “a disc-shaped portable mass-storage medium.” By so amending, the claimed invention is even further patentably distinguished over Yacoob.

It is well settled that:

“A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1567, 7 USPQ2d 1057 (Fed. Cir. 1988).”

Should the Office continue to believe that independent claim 1, as newly amended, is still anticipated by the asserted prior art, a citation of where each and every claimed feature, either as

column number and line number, or figure number and reference numeral, or a combination thereof, as disclosed in the asserted prior art is respectfully requested. Should the Office determines that any claimed feature is not disclosed in the asserted prior art, it is respectfully submitted that the claimed invention is not anticipated by the asserted prior art. Allowance of the claimed invention is then respectfully requested.

Claim Rejections - 35 U.S.C. §103

Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yacoob.

As mentioned in response to the rejection made hereinabove, independent claim 1, as newly amended, is further patentably distinguished over Yacoob. All claims dependent thereon, by virtue of inherency, are also further patentably distinguished over Yacoob.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 1-3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenthal (U.S. Patent No. 4,874,996).

In rejecting the claimed invention, the outstanding Office action has specifically stated that “Rosenthal fails to disclose that the storage medium is portable.” The Applicant agrees with this Office assessed shortcoming of Rosenthal. However, this is not the only shortcoming. Independent claim 1 has been amended to recite “a disc-shaped portable mass-storage medium having machine part information of the production machine recorded thereon, which machine part information comprises information on parts of the production machine, and also using data processing equipment including retrieval means for retrieving a part information from said

machine part information, copied from the disc-shaped portable mass-storage medium, depending on retrieval conditions, in order to input the retrieval conditions to the data processing equipment.”

Rosenthal fails to disclose or teach any storage medium that is in a disc shape.

Since Rosenthal fails to disclose a disc-shaped portable mass storage medium, Rosenthal naturally also fails to disclose all the other claimed features associated with the disc-shaped portable mass storage medium, including retrieval means for retrieving. Therefore, claims 1-3 are patentably distinguished over Rosenthal.

Reconsideration and withdrawal of this rejection are respectfully requested.

Prior Art Indicated To Be Pertinent To The Disclosure

The Office has provided a list of prior art indicated to be pertinent to the Applicant's invention. Consistent with the understanding as stipulated in MPEP 706.02 that only the best prior art should be applied, this list of prior art not having been applied by the Office, it is the Applicant's understanding that the Office must have considered the listed prior art to be no more pertinent than the applied prior art of record.

CONCLUSION

In view of the aforementioned remarks, all pending claims are believed to be in condition for allowance. Allowance of this application, at an early date, is respectfully requested.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any underpayment and credit any overpayment associated to this application to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

By: Michael N. Lau
Michael N. Lau
Reg. No.: 39,479
Attorney for Applicant
Tel: (202) 822-1100
Fax: (202) 822-1111

MNL/asc/rer

Q:\2001\010674\ Amendment - 1st OA due 5-23-04